

## REMARKS/ARGUMENTS

### *Claim Objections*

1. The Examiner objected to claim 6 as being of improper dependent form. Claim 6 has been amended to remove the dependence on claims 14 and 15.
2. The Examiner objected to claim 10 for including a typographical error. Said typographical error has been corrected via amendment.
3. Such changes add no new matter.

### *Claim Rejections - 35 USC §103*

4. The Examiner rejected claims 1-15 under §103(a) as being unpatentable (obvious) in view of Okada *et al.*
5. Applicant has amended claim 1 to include the limitation that the process includes at least one hydrogenated fatty acid as the “**only**” vehicle. Such change adds no new matter. The present invention is based on the use of the hydrogenated fatty acid as the only slow release agent (see page 3, third paragraph), whereas the use of the customary excipients represents only a possible alternative embodiment (see page 3, fourth paragraph). Thus, the slow release agents of the present invention are of **natural** origin.
6. In the Okada *et al.* reference, in contrast, the powder obtained by granulating the active principle and the oil, i.e. powder (A), is mixed before compression with a second powder (B) containing a water soluble polymer which is preferably selected from the group of hydroxyalkylcelluloses (see col. 1, ll. 54-60; col. 4, ll. 44-66; col. 5, ll. 27-35); that is, a standard **artificial** slow release agent.
7. Thus, the present invention is based on the use of slow release agents of natural origin, whereas Okada discloses that the presence of artificial slow release agents is necessary, thus teaching away from the present invention.
8. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” MPEP § 706.02(j).

9. The law regarding obviousness is clear--any modification of the prior art must be suggested or motivated by the prior art:

‘Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.’ [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious “modification” of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

*In re Fitch*, 972 F.2d 1260, 23 USPQ2d 1780, 1783-4 (Fed.Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

10. There is no motivation whatsoever provided by Okada *et al.* to provide a process which includes at least one hydrogenated fatty acid as the “**only**” vehicle.

11. It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed process does not by itself make the claimed process obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The Examiner finds the claimed shape would have been obvious, urging that (our emphasis) “it is obvious for one skilled in the art to form each hook base of any desired shape \*\*\* since *this is within the capabilities of such a person.*” Thus, the Examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or case law which makes “that which is within the capabilities of one skilled in the art” synonymous with obviousness.

The Examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

*Ex parte Gerlach and Woerner*, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

12. To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. *W.L. Gore & Assoc. v. Garlock, Inc.* 721 F.2d 1132, 1138, 220 USPQ 303, 312-13 (Fed. Cir. 1983). The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made. *Interconnect*

*Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985). In the present case, *Okada et al.* does not contain or suggest a process which includes at least one hydrogenated fatty acid (natural origin) as the “only” vehicle.

13. In determining the scope and content of the prior art, and determining whether the prior art suggested the claimed invention, the prior art reference “must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention.” *Akzo N.V. v. United States Int’l Trade Commission*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986); *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987).

14. In the instant case, there are a number of ways (discussed above) in which the *Okada et al.* reference diverges and teaches away from the claimed invention. In example, *Okada et al.* does not show a process which includes at least one hydrogenated fatty acid as the “only” vehicle, nor does *Okada et al.* show utilization only of a vehicle of natural origin, in fact teaching of the necessity of using artificial slow release agents.

15. Further, *Okada et al.* is complete and functional without the need for modification. Absent the need for modification to provide functionality, the reference could never lead one to make modifications to meet the claims as suggested by the Examiner.

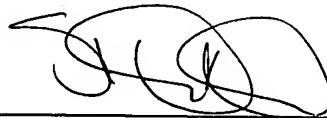
### ***Conclusion***

A *prima facie* case of obviousness has not been stated. First, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, the prior art reference fails to teach or suggest all the claim limitations. For these reasons, the present invention is not obvious in view of *Okada et al.*

If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below. Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 5 day of January 2004.

Very respectfully,



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STEPHEN M. NIPPER  
Reg. No. 46,260  
(208) 345-1122

CERTIFICATE OF MAILING

I HEREBY CERTIFY that this correspondence is being deposited with the United States Postal Service on the below date as first class mail in an envelope addressed to:

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Lindsey Ryan

A handwritten signature in cursive script, reading "Lindsey Ryan", is written over a horizontal line.